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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,296	06/23/2006	Heinrich Haas	062587-5011	4615
9629 7590 02/26/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
PURDY, KYLE A				
ART UNIT		PAPER NUMBER		
1611				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,296

Applicant(s)

HAAS ET AL.

Examiner

Kyle Purdy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/03/2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 23-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 and 23-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the arguments filed on 1/28/2009.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Prosecution is hereby reopened. Claims 1-15 and 23-32 are presented for examination on the merits. The following rejections are made.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Response to Applicants' Arguments

4. Applicants arguments filed 1/28/2009 regarding the rejection of claims 1 and 8-11 made by the Examiner under 35 USC 102(b) over Burke (US 5552156) have been fully considered and they are found persuasive. This rejection has been overcome by Applicants arguments.
5. Applicants arguments filed 1/28/2009 regarding the rejection of claims 1, 2, 4, 5, 7-11, 15 and 30 made by the Examiner under 35 USC 102(a) over Munich Biotech (EP 1393719) have been fully considered and they are found persuasive. This rejection has been overcome by Applicants arguments.
6. Applicants arguments filed 1/28/2009 regarding the rejection of claims 3, 6, 12-14, 16-29, 31 and 32 made by the Examiner under 35 USC 103(a) over Munich Biotech (EP 1393719) have

been fully considered and they are found persuasive. This rejection has been overcome by applicants arguments.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-11, 14, 15 and 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Haas et al. (US 2006/0128736, filed 06/26/2003).

9. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

10. Haas teaches a method for making camptothecin (CPT)-carboxylate formulations. The method requires providing empty cationic nanoparticles comprising DOTAP. The nanoparticles are then mixed with a solution of CPT-carboxylate (see [0141]-[0144]). The mixture of micelles and drug is aqueous. The molar ratio of drug to lipid is 1:9 (10 mol. %) (see [0141]). The pH of

the composition is to be between 7-8 (sec [0142]). Finally, the composition once made is suitable for administration to a subject (see [0163]).

11. Thus, the instantly rejected claims are anticipated by the disclosure of Haas.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. **Claims 1-15 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. (US 5552156, published 09/03/1996; of record) in view of Perez-Soler et al. (US 5834012, published 11/10/1998) and Allen et al. (US 6316024, published 11/13/2001).**

15. Burke is directed to liposomal and micellar stabilization of camptothecin (CPT) drugs. Methods for making camptothecin loaded micelles are disclosed (see Examples 3 and 10). Example 3 teaches mixing preformed zwitterionic micelles (see instant claims 8 and 9) in a suspension with camptothecin solution (see instant claim 7) and giving the mixture time to

equilibrate to form drug loaded micelles (see instant claims 1, 8 and 9). The mixture is aqueous (PBS) in nature (see instant claim 1). The micelles of Example 3 are made from dimyristoyl phosphatidylcholine (DMPC) which has a cationic ammonium head group and is amphiphilic (see instant claims 10 and 11). It is taught that camptothecin drugs bind the lipid bilayer membrane of the liposome and so it must be partially able to penetrate said membrane (see column 2, lines 10-15; see instant claim 1). The pH of the preparation is from between 3 and 7.4 (see Example 7 and lines 11-12; see instant claim 15). Moreover, formulations are disclosed where in CPT-carboxylate is used solely in the liposome.

16. Burke fails to include cationic lipids in the nanoparticle wherein the cationic lipid includes DOTAP or DMTAP. Moreover, Burke fails to teach that their method require a mixing time of between 10 minutes to 6 hours and an incubation temperature of between 4°-25°C.

17. Perez is directed to lipid complexed topoisomerase inhibitors (TII). An exemplified TII is camptothecin and its carboxylate salt (see column 3, lines 25-30). The lipids used to carry the TII includes cationic lipids (see column 4, lines 55-65) such as SOTAP, DOTMA and DODAP (see instant claims 1 and 30). It's taught that cationic lipids such as these assist in complexing and maintaining the stability of the encapsulated compounds. The ratio of lipid to drug is to be from 150:1 to 5:1 (see column 4, lines 45-50; see instant claims 3 and 23-25).

18. Allen is directed to therapeutic liposome compositions and methods of making said compositions. The method of making the active liposomes requires preforming the liposomes which may comprise cationic lipids such as DOTAP (see column 6, lines 15-30) and incubating said micelle with an active agent. Disclosed active agents include camptothecin and its analogs (see column 8, line 45). The method may performed various ways such as passive entrapment of

the compound by hydrating the lipid film with the compound (i.e. self assembly) (see column 10, line 5). The method of loading the agent requires incubating at either 25 or 37°C and the time is varied from between 0-5 hours (see Example 1; see instant claims 12, 13, 31 and 32). It's shown that the longer the incubation time, the greater the loading efficiency of the agent to be encapsulated (see figs. 2A-2D).

19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Burke, Perez and Allen with a reasonable expectation for success in arriving at a method of producing cationic micelles loaded with CPT-carboxylate by a) providing an active agent; b) providing empty cationic nanoparticles; and c) incubating the active agent of a) with the nanoparticles of b) for a time sufficient to load the nanoparticles with the active agent wherein the loading process is a self-assembly process. With respect to the requirement that the CPT be under 4% lactone, this is implicit to the teaching of Burke because Burke teaches a micellar composition which has as its active agent CPT-carboxylate. With respect to using a cationic lipid to form a cationic micelle, this is obvious. Perez teaches that cationic lipids are useful in CPT containing micelles because their inclusion helps to stabilize and maintain the drug. One would have been motivated to modify the teaching of Burke with such cationic lipids with a reasonable expectation in imparting a stabilizing effect for the encapsulated CPT drug. With respect to the incubation time and temperature, this is also obvious, especially in view of Allen. Both Burke and Perez are directed to making micellar CPT formulations but neither specifically disclose the instantly claimed temperature and time ranges. While it would have been obvious for any person of ordinary skill to optimize such parameters, Allen is relied upon to show that he instantly claimed ranges are commonly employed in the art

for the loading of actives into micelles and are obvious. It's clear from Allen's teachings that time and temperature directly influence the fraction of active encapsulated by the liposome. Thus, it would have been obvious to any person of ordinary skill in the art to adjust and optimize the time and temperature of the incubation period such that the loading efficacy of the method could be sufficiently adjusted to allow for maximum loading efficiency of camptothecin into the micelles. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner, Art Unit 1611
February 17, 2009*

*/David J Blanchard/
Primary Examiner, Art Unit 1643*